THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

_____

Ex parte HOWARD W. LONG, Dec'd

_____

Appeal No. 1997-2277
Application 08/462,814[1]

_____

ON BRIEF

_____

Before WINTERS, WILLIAM F. SMITH and SPIEGEL Administrative Patent Judges,

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

[1]Application for patent filed Jun. 5, 1995. According to appellant, this application is a division of Application No. 07/655,675, filed Feb. 14, 1991 (now U.S. Patent No. 5,441,360), which is a continuation-in-part of Application No. 07/284,744, filed Dec. 9, 1988 (abandoned), which is a continuation-in-part of Application No. 07/149,686, filed Jan. 28, 1988 (abandoned).

This is an appeal under 35 U.S.C. § 134 from the final rejection of claims 1 through 8, all the claims pending in the application.

Claim 1 is illustrative of the subject matter on appeal and reads as follows:

1. An asphaltic concrete compound for either as a top layer of paving, or at least the first bottom layer of a pavement patch and then the top layer of a pavement patch, to efficiently intercept microwave energy whenever directed downwardly to the top layer of paving, or to the first bottom layer of a pavement patch and then to the top layer of a pavement patch, to generate heat in these respective layers, so the generated heat will be efficiently conducted essentially to the surface of these top layers, to debond ice which had previously bonded to the surface of these layers, for the purpose of readily removing the debonded ice from paving, and in respect to pavement patches, when necessary, readily removing the debonded ice, while also heating the surfaces of the pavement hole to aid in the bonding of the asphaltic concrete compound used in filling the pavement hole, comprising:

aggregate, comprising gravel, rocks, and the added lossy microwave anthracite material; and

asphalt cement surrounding the aggregate;

whereby, the added lossy microwave anthracite material is included in a quantity large enough to efficiently intercept microwave energy, which is directed downwardly to the surfaces of this asphaltic concrete compound (emphasis added).

I. References

The references relied on by the examiner are:

Fukushima et al. (Fukushima) 4,008,095 Feb. 15, 1977

Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc. (1986), p. 90.

II. Rejection[2]

The appealed claims stand rejected under 35 U.S.C. § 102(b) as anticipated by Fukushima.

On consideration of the record, we reverse this rejection.

III. Discussion

1. The claims are directed to an asphaltic concrete compound comprising (a) aggregate that comprises gravel, rocks, and added lossy microwave anthracite material, and (b) asphalt cement surrounding the aggregate. Claim 1 recites that the lossy microwave anthracite material is included in a quantity large enough to efficiently intercept microwave energy.

2. The examiner's rejection under 35 U.S.C. § 102(b) is predicated on the following findings of fact, which we find are not supported by the evidence of record. See Final Rejection, Paper No. 5, page 2.

(1) "The reference [Fukushima] teaches an asphalt composition comprising stone aggregate (column 4, lines 2-6)."

---

[2]The amendment after Final, Paper No. 6, addressing the rejection of claim 6 under 35 U.S.C. § 112, set forth at page 3 of the Final Rejection, Paper No. 5, has been entered. See the Advisory Action, Paper No. 7. The examiner does not repeat or refer to the § 112 rejection in the Examiner's Answer. Therefore, as a matter of standard procedure, the previously entered rejection of claim 6 under 35 U.S.C. § 112 has been withdrawn. See Paperless Accounting, Inc. v. Bay Area Rapid Transit System, 804 F.2d 659, 663, 231 USPQ 649, 651-52 (Fed. Cir. 1986). MPEP § 707.07(e) (Rev. 1, Feb. 2000).

(2) “Every material limitation of applicant’s claims is met.”

Findings (1) and (2) are erroneous. Fukushima’s paving composition does not comprise stone aggregate, nor does it comprise an anthracite material. Thus, not all the claim limitations are met. Fukushima at column 4, lines 3-8, discloses that tars and coal oils are “remarkedly [sic] effective for improving the adhesive property of the present paving composition to natural aggregates, such as water-wetted ground stone and pebbles, baked synthetic aggregates . . . and cement concretes (emphasis added).” These “natural aggregates” are a type of surface on which the paving composition is deposited, not a component of the paving composition. Further, according to Fukushima, “[a]s the coal to be used in this invention, peat, lignite, brown coal, bituminous coal or the like may be employed along [sic] or in mixtures thereof (emphasis added).” Column 2, lines 15-18. Fukushima discloses that “the coal is porous.” Column 2, lines 22-23. Fukushima does not describe the use of anthracite in his paving composition..

(3) “Examiner’s analysis corresponds to the analysis of the board in their [sic] decision in the parent application [Application No. 07/655,675].”

In this application, the examiner argues that Fukushima describes appellant’s claimed composition. 35 U.S.C. § 102(b). On the contrary, in Application 07/655,675, the rejection was stated under 35 U.S.C. § 103 and the issue was whether it would have been obvious to use the anthracite coal disclosed at page 43 of Grant & Hackh’s Chemical

Dictionary, Fifth Edition (1987), in Fukushima's paving composition. In the '675 application, the appealed claims recited an asphaltic concrete compound comprising anthracite, as an added lossy microwave material. There, the merits panel was not asked to consider, and did not consider, a rejection arising under 35 U.S.C. § 102. The examiner's analysis in the instant application does not "correspond" to the analysis of the previous merits panel in a rejection arising under 35 U.S.C. § 103. See Application No. 07/655,675, Paper No. 21 (Appeal No. 1993-4448, mailed Jun. 22, 1994), page 5, line 10, through page 6, line 15.

(4) "Webster's provides evidence of the fact that anthracite is mineral coal and encompassed by the disclosure of Fukushima et al."

Webster at page 90 does not identify anthracite as "mineral coal" but as "a hard natural coal of high luster differing from bituminous coal in containing little volatile matter."

For these reasons, the examiner has not established a prima facie case of anticipation under 35 U.S.C. § 102(b).

3. One further matter warrants attention. This application is said to be a division of Application No. 07/655,675. See the Declaration, filed Jun. 5, 1995, page 2, lines 1-3. However, the face of the file wrapper indicates, incorrectly, that this application is a continuation-in-part of Application No. 07/655,675. Upon return of the application, the

examiner should ensure that all appropriate PTO records, including the file wrapper, are updated to reflect the correct family history.

IV. Conclusion

In conclusion, for the reasons set forth in the body of this opinion, we reverse the rejection of claims 1 through 8 under 35 U.S.C. § 102(b) as anticipated by Fukushima.

REVERSED

| | |
|---|---|
| SHERMAN D. WINTERS<br>Administrative Patent Judge | ) |
| WILLIAM F. SMITH<br>Administrative Patent Judge | ) BOARD OF PATENT<br>) APPEALS AND<br>) INTERFERENCES |
| CAROL A. SPIEGEL<br>Administrative Patent Judge | ) |

Roy E. Mattern Jr.
13415 SE 30th
Bellevue, WA 98005-4405

SDW/jlb